



**UNITED STATES DEPARTMENT OF COMMERCE  
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*RE*

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/244,374	02/04/99	HOLLIDAY	D 1575.001

QM02/0724

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EXAMINER

HALE, G

ART UNIT

PAPER NUMBER

3741

*2*

DATE MAILED: 07/24/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/244,374

Applicant(s)

Holliday

Examiner

Hale

Group Art Unit

3741



☐ Responsive to communication(s) filed on \_\_\_\_\_

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-10 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1-10 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Reissue Applications*

1. The reissue oath/declaration filed with this application is defective because it fails to contain a statement that all errors which are being corrected in the reissue application up to the time of filing of the oath/declaration arose without any deceptive intention on the part of the applicant. See 37 CFR 1.175 and MPEP § 1414.

The original patent, or an affidavit or declaration as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 1-10 are rejected as being based upon a defective declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

2. Claims 5-10 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which

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the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

The broader scope surrendered in original claim 1 was that the breast protector includes “a means for flexing along a longitudinal axis passing through said center sternum area”. Applicants new claim 5, is an attempt to recapture the broad requirement of claim 1 above and is written as “wherein said center sternum area has flexibility therein along a longitudinal axis”. The Original Examiner required, in order to allow claim 1, that the claim include that the soft rubberized foam exterior and interior surrounding the internal breast plate in it’s entirety (claim 1, part “b”) and that the “means for flexing” be amended to include a “sternum hinge member having flexibility along a longitudinal axis passing between said right and left cup”. (Claim 1, removal of part “d” and addition of part “e”).

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The Original Examiner indicated that the allowable subject matter was that which was included in original claim 5 that the flexing means included an upper and lower hinge member. This was indicated on page 4 of the 08/617,507 paper number 2 of 8/12/96. Therefore, any new claims in the present application must include the above stated subject matter in order to avoid an improper recapture of broadened claimed subject matter.

3. Claims 1-10 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 5 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Martin et al.

In regard to claim 5 Martin discloses a chest and breast protector comprising an internal breast plate formed as a unitary member with a right cup, left cup and center sternum area

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which is flexible along the center since the entire protector is "semi-rigid" not entirely rigid and would thereby allow for flexibility as claimed and in that it is 3mm thick polyethylene it would allow for the claimed flexibility. Martin also discloses the resilient encasement as broadly claimed in claim 7 in that it includes foam around the periphery. (See Martin, figure 1 and lines 33-78).

6. Claims 5, 7, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Barnes.

Barnes discloses the chest protector for women including the left cup,(56) right cup(54) and center sternum portion(60) with the flexibility as claimed in the center as claimed in claim 5. Barnes also discloses the resilient encasement which surrounds the breast plates (74,76) as claimed in claim 7 and the vents in the breast plate as claimed in claims 9 and 10. (See Barnes figures 6 and 7 and col.2, line 36- line 55).

### *Conclusion*

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The Librande, Morehouse, Williams, McCleary and Harrison patents all disclose breast protector garments which are unitary as broadly claimed, formed into one piece and which contain the flexible center areas, breast plates and vent areas as broadly claimed.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gloria Hale whose telephone number is (703) 3081282.



Gloria Hale

Patent Examiner - Art Unit 3741

July 17, 2000